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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,583	09/08/2003	Thomas G. Cremers	6197US	9891

30173 7590 06/06/2005

GENERAL MILLS, INC.  
P.O. BOX 1113  
MINNEAPOLIS, MN 55440

EXAMINER
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HUYNH, LOUIS K

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/657,583	CREMERS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Louis K. Huynh	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 2/7/05 and the phone interview on 5/3/05.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-17 and 32 is/are pending in the application.
  - 4a) Of the above claim(s) 5-17 and 32 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. <u>05312005</u> .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Remarks***

1. The reply filed 02/07/2005 appears to be a bona fide attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of the Notice of Non Responsive Reply, which was mailed on 04/05/2005.
2. Applicant has made a provisional election with traverse of Group I, claims 1-4, and the new claim 32 for prosecution on the merits over the phone on 05/03/2005, which was within the given time period; therefore, no extension fee is necessary.
3. Claims 18-31 have been canceled and a new claim 32 has been added by the reply filed on 02/07/2005.

### ***Election/Restrictions***

4. Applicant's election with traverse of Group I, claims 1-4 and the new claim 32, in a telephone interview conducted on May 03/2005 (see attached Interview Summary), with traverse is acknowledged. The traversal is on the ground(s) that the new claim 32 is directed to an overall assembly which includes a first apparatus to fold the insert directly corresponding to that of claim 1, an apparatus for nesting taco shells directly corresponding to that set forth in claim 11, an apparatus for placing an insert within a nested group of taco shells directly corresponding to that set forth in claim 5, and an apparatus for aligning the nested taco shells directly corresponding to that set forth in claim 15; thus represents a combination and linking claims 1, 5, 11 and 15; and that each of claims 1-17 represents sub-combination claim of the overall combination set forth in claim 32.

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5. This is not found persuasive because MPEP § 806.05(c) states: "If there is no evidence that combination AB<sub>sp</sub> is patentable without the detailed of B<sub>sp</sub>, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination B<sub>sp</sub> constitutes the essential distinguishing feature of the combination AB<sub>sp</sub> as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombinations has a separate utility." However, it has been found that either of the subcombinations A<sub>sp</sub>, B<sub>sp</sub>, C<sub>sp</sub>, D<sub>sp</sub> alone is essential to the combination A<sub>sp</sub>B<sub>sp</sub>C<sub>sp</sub>D<sub>sp</sub> of the new claim 32, and each of the subcombination has a separate utility by itself. Therefore, the combination and the subcombinations are distinct inventions and are restricted from one another.

6. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, drawn to an apparatus for folding an insert, classified in class 493, subclass 416.
- II. Claims 5-10, drawn to an apparatus for placing an insert, classified in class 221, subclass 211.
- III. Claims 11-14, drawn to a conveyor, classified in class 198, subclass 464.1.
- IV. Claims 15-17, drawn to an apparatus for aligning a nested group of articles, classified in class 53, subclass 147.
- V. Claim 32, drawn to a combination, classified in class 53, subclass 537.

7. The inventions are distinct, each from the other because of the following reasons:

- Inventions I, II, III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has

separate utility such as folding a sheet of paper, invention II has separate utility such as placing a coupon on to an article, invention III has separate utility such as conveying a group of articles, and invention IV has separate utility such as aligning a group of articles. See MPEP § 806.05(d).

- Inventions V and each of inventions I-IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of any of the subcombinations as claimed for patentability, and (2) that each of the subcombinations has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed for patentability because other subcombination in the combination is also patentable by itself. The first subcombination has separate utility such as folding an insert, the second subcombination has separate utility such as placing an insert, the third subcombination has separate utility such as conveying a group of taco shells, and the fourth subcombination has separate utility such as aligning a nested group of taco shells.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for one group might not be required for other groups, and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. The requirement is still deemed proper and is therefore made FINAL.

11. As a result, claims 5-17 and 32 have been withdrawn from further consideration as being drawn to non-elected inventions.

***Specification***

12. Applicant is reminded of the proper content of an abstract of the disclosure. A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. In this case, the claimed invention is directed to an insert folding apparatus. Applicant is respectfully requested to provide an abstract directed to the claimed invention. Extensive mechanical and design details of apparatus should not be given.

***Claim Objections***

13. Claim 2 is objected to for being dependent to a non-existing claim 0 (See Amendment filed 02/07/2005). For purpose of examination, claim 2 is assumed to be dependent of claim 1. Applicant is respectfully request to affirmed the dependency of claim 2 in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 appears to be incomplete for lacking an essential mechanism for moving the insert pass the folder fingers. This mechanism is considered essential because the folding apparatus as claimed would not work without such device.

Claim 4 lacks the structural/functional relationship between the insert magazine and the folding apparatus.

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1, 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Budde et al. (US 5,300,011).

With respect to Claim 1, Budde discloses an apparatus for folding an object (12) including: first and second pivot shafts, first and second lever arm (78) respectively perpendicularly connected to the first and second pivot shafts, and a first and a second folder finger (74a) substantially perpendicularly connected to the first and second pivot shafts, wherein

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the folder fingers are adapted to engage the object (12) as it passes the folder fingers (74a) (FIGS. 6, 7 & 9H).

With respect to Claim 2, Budde further discloses in FIGS 6 & 7 a third and fourth pivot shafts connecting the lever arms (78) to a reciprocating plate (76). The third and fourth pivot shafts are considered to be cam followers since they follow the reciprocating movement of the plate (76).

***Allowable Subject Matter***

18. Claims 3 and 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

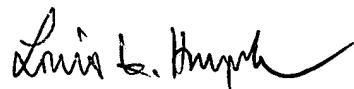
19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure has been cited on form PTO-892 along with the applied prior art.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis K. Huynh whose telephone number is (571) 272-4462. The examiner can normally be reached on M-F from 9:30AM to 5:00PM.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Louis K. Huynh  
PRIMARY EXAMINER  
Art Unit 3721

May 31, 2005